

REMARKS

Claims 1-42 and 105-135 were pending and have been examined by the United States Patent and Trademark Office (hereinafter "the Patent Office") in a Non-Final Official Action dated July 28, 2010 (hereinafter "the Non-Final Official Action"). A Notice of Appeal was timely filed on January 28, 2011 along with a Pre-Appeal Brief Request for Review. A Notice of Panel Decision from Pre-Appeal Brief Review dated March 14, 2011 set a one month extendable deadline for filing the Appeal Brief. In lieu of an appeal brief, Applicants respectfully submit this Amendment and Request for Continued Examination (RCE).

The pending claims have been rejected under 35 U.S.C. § 103(a) upon the contention that the claims are unpatentable over one or more of the following references or combinations of references:

1. U.S. Patent No. 6,281,189 to Heimann et al. (hereinafter "Heimann") in view of U.S. Patent Application Publication No. US 2003/0213747 of Carbonell et al. (hereinafter "Carbonell");
2. U.S. Patent No. 5,143,639 to Krawack (hereinafter "Krawack") in view of Carbonell;
3. Krawack in view of Carbonell, and further in view of Heimann;
4. U.S. Patent No. 5,413,729 to Gaul (hereinafter "Gaul");
5. Gaul, and further in view of Heimann, U.S. Patent No. 5,421,907 to Nieendick et al. (hereinafter "Nieendick"), or U.S. Patent No. 5,194,173 to Folkard et al. (hereinafter "Folkard");
6. Gaul, and further in view of U.S. Patent No. 6,030,466 to Myers, II (hereinafter "Myers, II");
7. Gaul in view of Carbonell; and
8. Gaul in view of Heimann, Nieendick, or Folkard, and further in view of Carbonell and U.S. Patent No. 6,544,942 to Smith et al. (hereinafter "Smith") or U.S. Patent No. 6,838,426 to Zeilinger (hereinafter "Zeilinger").

Claims 1-19, 21-28, 33-43, 105-122, 124-126, and 129-135 have been rejected under the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 7,547,672 to Zaki (hereinafter "Zaki") in view of Carbonell.

Claims 1, 110, 111, and 128 have been amended. The amendment to claim 1 is to delete "(g)", and thus is believed to be formal in nature only. The amendments to claims 110 and 128 relate to the recitation of specific aromatic and aliphatic esters. Support for these amendments can be found through the specification as filed, including particularly at page 14, lines 3-4 (aromatic ester is isopropyl benzoate) and at page 15, lines 25-29 (aliphatic ester is in

some embodiments a fatty acid alkyl ester, which in some embodiments is biodiesel). The amendment to claim 111 is believed to be formal in nature to harmonize the claims language to the amended language of claim 110. Thus, no new matter has been added by the amendments to the claims.

Reconsideration of the application as amended and in light of the remarks set forth herein below and the Second Declaration of Robert E. Troxler Pursuant to 37 C.F.R. § 1.132 (hereinafter the "Second Troxler Declaration") submitted herewith is respectfully requested.

II. Responses to the Rejections under 35 U.S.C. §103(a)

Each of the pending claims has been rejected under 35 U.S.C. § 103(a) upon the contention that the claim is unpatentable over one or more of the references and/or combinations of references listed herein above.

After careful consideration of the rejections and the Patent Office's bases therefor, applicants respectfully traverse the rejections and submit the following remarks.

II.A. Response to the Rejection over Heimann in view of Carbonell

Claims 1-42, 105-107, 110-116, and 119-135 have been rejected over the combination of Heimann in view of Carbonell. According to the Patent Office,

Heimann et al teach a composition containing at least one soybean oil derived compound and at least one member chosen from the group of drying agent(s), cosolvents, and additives. The composition can comprise methyl soyate, and d-limonene. See Abstract. More specifically, the composition contains from 0.5 to 20% by weight of at least one drying agent, about 1 to about 30% by weight of at least one cosolvent, additives from 0 to about 25% by weight, and 5 to 75% by weight of methyl soyate. See column 1, lines 45-69. Suitable additives include surfactants (e.g. anionic and nonionic), emulsifiers, antimicrobial compounds, etc. Suitable co-solvents include water, hydrocarbon glycols, and mixtures thereof among others. See column 2, lines 10-65. The compositions can replace toxic chlorinated solvents among other conventional and environmentally undesirable cleaners/solvents. Additionally, additives may be added to the compositions including dipropylene glycol n-butyl ether (butyl carbitol), etc. See column 2, lines 50-65. The inventive composition can be employed as a general purpose cleaner, parts cleaner, engine degreaser, tar and asphalt removal, printing press cleaner, metal cleaner, etc. See column 1, lines 30-45.

Non-Final Official Action at pages 4-5. The Patent Office concedes that Heimann does not teach "the use of a benzoic acid ester or a composition having the specific physical parameters containing a benzoic acid ester, methyl soyate, nonionic surfactant, water, and the other requisite components of the composition in the specific amounts as recited by the instant claims. The Patent Office asserts, however, that this deficiency is cured by Carbonell, which is asserted to teach:

environmentally friendly solvents used to dissolve or remove residues and/or substances from substrates wherein the residue and/or substance is contacted with a generally recognized as safe solvent (GRAS) to dissolve the residue and/or substance in the solvent followed by the extraction of the residue and/or substance from the solvent such as by contact with carbon dioxide. See Abstract. These GRAS solvents are environmentally responsible solvents and include benzoic acid ester solvents such as methyl benzoic acid ester, isopropyl benzoic acid ester, methyl salicylate, ethyl salicylate, etc. See paras. 38-45. Preferably, the ester-containing solvent contains at least about 70-99% by weight of the one or more esters. See para. 50.

See Non-Final Official Action at page 5. From this, the Patent Office contends that it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use a benzoic acid ester solvent in the cleaning composition taught by Heimann with a reasonable expectation of success, because, according to the Patent Office, Carbonell "teach[es] the use of solvents such as benzoic acid esters in similar cleaning compositions and that benzoic acid esters are environmentally friendly solvents" and Heimann "teach[es] the use of various cosolvents which would encompass benzoic acid ester solvents". See Non-Final Official Action at pages 5-6.

And finally, the Patent Office asserts:

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a composition containing a benzoic acid ester, methyl soyate, nonionic surfactant, water, and the other requisite components of the composition in the specific amounts as recited by the instant claims, with a reasonable expectation of success and similar results with respect to other disclosed components, because the broad teachings of Heimann et al in combination with Carbonell et al suggest a composition containing a benzoic acid ester, methyl soyate, nonionic surfactant, water, and the other requisite components of the composition in the specific amounts as recited by the instant claims.

Note that, with respect to the pH, flash point, and other characteristics of the composition as recited by the instant claims (more specifically, instant claim 110), the Examiner asserts that the teachings of Heimann et al in combination with Carbonell et al would suggest compositions having the same pH, flash point, and other characteristics of the composition as recited by the instant claims because Heimann et al in combination with Carbonell et al suggest compositions containing the same components in the same proportions as recited by the instant claims.

See Non-Final Official Action at page 6.

After careful consideration of the rejection and the Patent Office's basis therefor, applicants respectfully traverse the rejection and submit the following remarks.

The Patent Office asserts that Heimann teaches a composition containing at least one soybean oil-derived compound and at least one member chosen from the group of drying agent(s), co-solvents, and additives. With respect to the co-solvent, Heimann asserts to teach that the co-solvent can be present in 1 to about 30% by weight, and the methyl soyate can be present in 5 to 75% by weight. Further regarding the co-solvent, the Patent Office asserts that Heimann teaches in col. 2, lines 10-65 that suitable co-solvents include water, hydrocarbon glycols, and mixtures thereof, among others. Thus, the Patent Office asserts that one of ordinary skill in the art would have been motivated to produce a composition that has 5 to 75% by weight of methyl soyate and 1-30% of benzoic acid ester solvents such as methyl benzoic acid ester, isopropyl benzoic acid ester, methyl salicylate, ethyl salicylate, etc. because "co-solvent" as used in Heimann would encompass the GRAS solvents disclosed in Carbonell. The Patent Office further asserts that "cosolvent" as described in Heimann will be given its broadest reasonable interpretation which would be an additional solvent enhancing the cleaning ability of the first solvent.

Applicants respectfully disagree that the Patent Office has adopted the proper approach to examination with respect to the term "co-solvent". Particularly, applicants respectfully submit that the Patent Office is believed to be incorrect with respect to giving the term "co-solvent" its broadest reasonable interpretation in the context of how that term is being used in the cited references.

To elaborate, applicants respectfully submit that the Patent Office must consider the references and all terms presented therein as they would be understood by one of ordinary skill in the art within the context of the reference as a whole. This is clearly set forth in M.P.E.P. § 2141.02, "Ascertaining the differences between the prior art and the claims at issue requires interpreting the claim language, and considering both the invention and the prior art references as a whole (emphasis added). As set forth in applicants' previous amendment, it is clear from a complete reading of Heimann that the meaning of the term "co-solvent" as used therein is different than the meaning that has been ascribed to the term by the Patent Office in the instant prosecution. Stated again, applicants respectfully submit that a benzoic acid ester would not have been viewed as a "co-solvent" within the meaning that term would be given by one of ordinary skill in the art upon review of Heimann because benzoic acid esters would not have been expected to increase the solubility of methyl soyate and d-limonene in water as Heimann's co-solvents were designed to do.

Thus, applicants respectfully submit that the Patent Office's assertion that "the definition of 'cosolvent' as described in the instant specification is not necessarily applicable to the

teachings of Heimann nor is the ‘cosolvent’ as taught by Heimann limited to the definition given in the instant specification” (see Non-Final Official Action at page 19) is not the appropriate inquiry. Rather, applicants respectfully submit that they have argued not that this term as used in Heimann must conform to the definition employed by applicants, but that in fact Heimann does employ the term exactly as applicants employed it in their specification. As such, applicants respectfully submit that the Patent Office’s attempt to broaden the definition of “cosolvent” beyond that which one of ordinary skill in the art would attribute to the term after review of Heimann is believed to be clearly improper.

Therefore, applicants respectfully reiterate that one of ordinary skill in the art would not have looked to Carbonell to provide any aromatic ester as a co-solvent for combining with the compositions of Heimann. As a result, applicants respectfully submit that the Patent Office has failed to provide any reasonable basis by which one of ordinary skill in the art would have employed a benzoic acid ester solvent as a co-solvent in the compositions of Heimann.

Continuing, applicants further respectfully submit that as has been clearly set forth by the Court of Appeals for the Federal Circuit (CAFC) in *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) and cited with approval in *KSR v. Teleflex*, 550 U.S. at 418, “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” (emphasis added). Applicants respectfully submit that the Patent Office’s attempt to take a given term presented in a first reference out of context and re-define it in order that it might encompass another claimed element disclosed in a second reference, when the term in fact would not encompass the claimed element when the term is considered in the proper context of the first reference, falls far short of the “articulated reasoning with some rational underpinning” that is required by the CAFC in *In re Kahn*. Thus, applicants respectfully submit that the Patent Office has articulated no reasonable basis by which one of ordinary skill in the art would have combined Heimann’s methyl soyate with any amount of a benzoic acid ester, let alone the particular percentages of the aromatic esters and aliphatic esters recited in the instant claims.

Additionally, applicants respectfully reiterate that each and every claim includes a specific amount of the aromatic ester and the aliphatic ester, and the Patent Office has set forth no articulated reasoning by which one of ordinary skill in the art would have selected the particular percentages of the components of the compositions that are recited in the claims. As set forth by the CAFC in *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988), “In order to establish a *prima facie* case of obviousness, the Examiner must show that each and every limitation of

the claim is described or suggested by the prior art or would have been obvious based on the knowledge of those of ordinary skill in the art" (emphasis added). Applicants respectfully submit that the instant rejection amounts to no more than a conclusory assertion that one of ordinary skill in the art.

Furthermore, applicants respectfully submit that the various pending claims include specific percentage elements with respect to the aromatic esters and the aliphatic esters. For example, claims 1, 110, and 112 all recite that the aromatic ester is present in an amount of about 10-60% by weight and the aliphatic ester is present in an amount of 30-60% by weight. With respect to the aromatic esters, claims 6 and 7 recite that the aromatic ester is present in at least 50% or at least 40%, respectively; claims 29 and claims 30-32 recite that the aromatic ester is present at about 50% or about 40%, respectively; claims 105-107 recites that the aromatic ester is present in 40-60% by weight, about 40%, or about 50%; claim 111 recite that the aromatic ester is present in 50-60% by weight; claims 115 and 116 recite that the aromatic ester is present in at least 40% or at least 50% by weight, respectively; claim 127 recites that the aromatic ester is present in about 50% by weight; claim 128 recites specific embodiments wherein the aromatic ester is present in either about 40% or about 50% by weight; and claim 135 recites that the aromatic ester is present in about 40% to about 60% by weight. Thus, applicants respectfully submit that at least with respect to these claims and claims dependent therefrom, even if one of ordinary skill in the art were to add an aromatic ester as a co-solvent to Heimann's composition, the maximum that would be employed is about 30% (see Heimann at col. 1, lines 51-53: "The composition can also include at least one co-solvent for the soybean oil derived compound and/or the drying agent, e.g., about 1 to about 30 wt % of one or more co-solvents" (emphasis added)). Applicants respectfully submit that not only does the explicit disclosure of Heimann state that the co-solvent is for the soybean oil derived compound and/or the drying agent, meaning that it is not "another solvent" as asserted by the Patent Office, but also that it is present in "about 1 to about 30 wt %".

As such, applicants respectfully submit that at least those of the instant claims that relate to compositions with "about 40%", "at least 40%", "about 50%", "at least 50%", or any range that has as its lower limit at least 40% and/or at least 50% are believed to be distinguished over Heimann combined with Carbonell.

However, with respect to this argument that applicants have previously presented, the Non-Final Official Action states, "the Examiner asserts that 'about 30%' by weight of a cosolvent would fall within the scope of 'about 40%' of an aromatic ester as recited by the instant claims" (see Non-Final Official Action at page 20). The Examiner provides no basis for this conclusion,

and thus it is believed that an attempt to extend the term "about" to include a deviation of 25% of the stated value is improper.

Thus, for this additional reason, applicants respectfully submit that the Patent Office has not presented a *prima facie* case of obviousness of at least claims 6, 7, 29-32, 105-107, 111, 115, 116, 127, 128, and 135, and dependents thereof.

Notwithstanding the above, even if the Patent Office has established a *prima facie* case of obviousness of claims 1-42, 105-107, 110-116, and 119-135 over Heimann and Carbonell, which applicants do not concede has been established, applicants respectfully submit that the instantly claimed compositions are characterized by unexpectedly superior properties that are sufficient to rebut the Patent Office's alleged *prima facie* case. Several lines of evidence support the unexpectedly superior properties of the claimed compositions.

First, the specification as filed compares bitumen removal obtained from different solvent compositions in Table 2 that demonstrates that the claimed compositions are superior to diesel fuel. Nine different mixtures of an exemplary aromatic ester (isopropyl benzoic acid ester; IPB) and an exemplary aliphatic ester (biodiesel) all show at least 23% better solvent efficiency than diesel fuel.

Second, a Declaration of Robert E. Troxler Pursuant to 37 C.F.R. § 1.132 submitted December 23, 2008 (hereinafter the "First Troxler Declaration") demonstrated that 100% diesel fuel dissolved 16% of the available asphalt, 100% biodiesel dissolved 1.07% of the available asphalt, 100% IPB dissolved 46.9% of the available asphalt, and an exemplary mixture of the presently disclosed subject matter containing 54% IPB and 40% biodiesel dissolved 42.7% of the available asphalt. As set forth in the First Troxler Declaration, the 54% IPB/40% biodiesel might have been expected to dissolve 25.7% of the available asphalt based on the relative fractions of the mixture that corresponded to the IPB and biodiesel, and thus this mixture was about 1.8-fold more efficient than would have been expected.

However, the Patent Office asserted in the Non-Final Official Action that the "data presented in the 132 Declaration is not commensurate in scope with the instant claims. See Non-Final Official Action at page 23. The Patent Office's explanation with respect to this allegation fails to demonstrate, however, why the Patent Office believes that the data presented in the First Troxler Declaration fails to support the full scope of the claims, at least with respect to claims 6, 7, 29-32, 105-107, 111, 115, 116, 127, 128, and 135, and dependents thereof. Applicants respectfully submit that the Patent Office has provided no reasoned analysis as to why one of ordinary skill in the art would not have believed that the data presented therein would not be reasonably extendable to the subject matter of these claims.

Nonetheless, in a further attempt to demonstrate the unpredictably superior characteristics of the claimed compositions, applicants hereby submit a Second Declaration of Robert E. Troxler Pursuant to 37 C.F.R. § 1.132 (hereinafter the "Second Troxler Declaration"). As set forth therein, the ability of exemplary compositions of the presently disclosed subject matter (referred to therein as "BindOff" but also represented by the mixtures shown in Table 2) to dissolve asphalt was compared to various other compositions, including diesel fuel, biodiesel alone, methyl soyate alone, and exemplary compositions consistent with the disclosures of Heimann and Krawack.

Referring first to the data presented in Table 1, it is noted that each of biodiesel alone, methyl soyate alone, and the exemplary compositions consistent with the disclosures of Heimann and Krawack represent examples of compositions that include only aliphatic esters. As shown in Table 1, each and every such composition was a poor asphalt solvent that was at best less than 60% as efficient as diesel fuel. In comparison, the exemplary mixture of the presently disclosed subject matter was about 1.5-fold more efficient than diesel fuel, was about 1.5-fold more efficient than the Krawack composition, was about 4.5-fold more efficient than the Heimann composition, was about 10-fold more efficient than biodiesel alone, and was over 100-fold more efficient than methyl soyate alone. Applicants respectfully submit that these enhanced efficiencies were not predictable based on the disclosures of these references, and thus represent unexpectedly superior properties.

Applicants further respectfully submit that the data presented in tables 2 and 3 are further evidence of the unexpectedly superior properties of the claimed compositions. Referring now to these data, applicants respectfully submit that eleven (11) different mixtures of IPB as a representative aromatic ester and biodiesel as a representative aliphatic ester were produced and tested in duplicate. The eleven mixtures constituted IPB from 0-100% and biodiesel from 100-0%. The average fraction of asphalt removed by each mixture is presented in Table 2. Summarily, 100% IPB removed about a 0.1150 fraction, 100% biodiesel removed a 0.0487 fraction, and mixtures of IPB and biodiesel removed fractions of intermediate values.

Looking more closely at the data of Table 2, however, shows the unexpectedly superior properties of the IPB/biodiesel mixtures. Initially, the mixtures were in each and every case markedly superior to biodiesel alone, which is consistent with the data presented in table 1 of the Second Troxler Declaration. Additionally, however, the mixtures were also superior to 100% IPB up to at least the 50:50 ratio point.

More importantly, however, it was determined that when the expected average fraction removed was calculated by taking into account the percentages of IPB and biodiesel present in

the mixtures in view of the efficiencies of 100% IPB and 100% biodiesel, it was determined that each and every mixture was at least as efficient as expected, and with the exception of the 80:20 biodiesel:IPB mixture, was at least about 14% to as much as about 65% more efficient than would have been expected.

Therefore, applicants respectfully submit that even if one of ordinary skill in the art were to mix an aliphatic ester as in Heimann with an aromatic ester as in Carbonell as asserted by the Patent Office, the instantly claimed compositions are characterized by more than additive efficiency with respect to dissolving asphalt. Applicants respectfully submit that this represents the unexpectedly superior properties of the claimed compositions that are believed to be sufficient to rebut the Patent Office's asserted *prima facie* case of obviousness of claims 1-42, 105-107, 110-116, and 119-135 over Heimann in view of Carbonell.

And finally, applicants have determined that the compositions of the presently disclosed subject matter have a further unexpectedly superior advantage in that they deposit on the articles treated therewith a non-stick coating. This non-stick coating thus not only removes the asphalt present, but also reduces the extent to which asphalt binds to the article in the future. This also reduces the frequency at which the articles need to be cleaned, which is also believed to be an unexpectedly advantageous characteristic of the presently claimed subject matter.

Accordingly, applicants respectfully submit that claims 1-42, 105-107, 110-116, and 119-135 have been distinguished over Heimann in view of Carbonell. As a result, applicants respectfully request that the instant rejection be withdrawn at this time.

II.B. Response to the Rejection over Krawack in view of Carbonell

Claims 1-19, 21-28, 33-42, 105, 110-116, 119-122, 124-126, and 129-135 have been rejected over the combination of Krawack in view of Carbonell. Summarily, this rejection appears to be based on the same theory as the previous rejection.

Applicants respectfully submit that Krawack in view of Carbonell fails to support a rejection of claims 1-19, 21-28, 33-42, 105, 110-116, 119-122, 124-126, and 129-135 for the same reasons set forth hereinabove with respect to the rejection of these claims over Heimann and Carbonell. Particularly, applicants respectfully submit that Krawack in view of Carbonell fails to suggest each and every element of the claims, and alternatively or in addition, the existence of the unexpectedly superior properties of the claimed compositions rebuts the Patent Office's alleged *prima facie* case.

Accordingly, applicants respectfully submit that the instant rejection of claims 1-19, 21-28, 33-42, 105, 110-116, 119-122, 124-126, and 129-135 over the combination of Krawack in view

of Carbonell is believed to have been addressed, and respectfully request that it be withdrawn at this time.

II.C. Response to the Rejection over Krawack in view of Carbonell,  
and further in view of Heimann

Claims 20 and 29-32 have been rejected over Krawack in view of Carbonell, and further in view of Heimann. According to the Patent Office, neither primary reference teaches the use of an odor-masking agent such as d-limonene, but that this deficiency is cured by Heimann.

Applicants respectfully disagree that Krawack in view of Carbonell and further in view of Heimann supports a rejection of claims 20 and 29-32 under 35 U.S.C. § 103(a). Particularly, applicants respectfully submit that each of claims 20 and 29-32 depends from claim 1, and thus includes all of the elements of claim 1. Given that Krawack in view of Carbonell, and further in view of Heimann fails to support a rejection of claim 1 under 35 U.S.C. § 103(a), applicants respectfully submit that this same combination does not support a rejection of claims 20 and 29-32 under the rule of M.P.E.P. § 2141.03 ("If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Accordingly, applicants respectfully submit that the instant rejection of claims 20 and 29-32 over Krawack in view of Carbonell, and further in view of Heimann is believed to have been addressed, and respectfully request that it be withdrawn at this time.

II.D. Response to the Rejection over Gaul

Claims 1-4, 6, 7, 11-19, 21-26, 33-42, 108, 110, 112-116, 120-122, 124, 125, and 129-134 have been rejected over Gaul. According to the Patent Office, Gaul teaches a composition for removing coatings such as paints from substrates which comprises at least one ester and at least one lactone, and suitable esters include at least one ester selected from the group comprising aliphatic esters or aromatic esters, and mixtures thereof.

Applicants respectfully note, however, that one of ordinary skill in the art would understand Gaul to require the presence of a lactone, and as such, cannot be reasonably interpreted to render obvious the instantly claimed compositions that do not include lactones.

As such, applicants respectfully submit that the Patent Office appears to be picking and choosing from Gaul only so much of the reference that supports the instant rejection. Applicants respectfully submit that this approach is specifically prohibited by the decision of the Court of Customs and Patent Appeals (CCPA) in *In re Wesslau* 53 CCPA 746, 353 F.2d 241 (1965) that stated, "It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of

other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art".

Accordingly, applicants respectfully submit that the instant rejection of claims 1-4, 6, 7, 11-19, 21-26, 33-42, 108, 110, 112-116, 120-122, 124, 125, and 129-134 Gaul is believed to have been addressed, and respectfully request that it be withdrawn at this time.

II.E. Response to the Rejection over Gaul, and further in view of Heimann, Nieendick, or Folkard

Claims 8-10, 105, 109, 117-119, and 135 have been rejected over Gaul, and further in view of Heimann, Nieendick, or Folkard. According to the Patent Office, Heimann, Nieendick, and/or Folkard cure the deficiency conceded in Gaul with respect to the use of a fatty acid methyl ester such as methyl soyate or an aliphatic ester such as 2-ethylhexyl ester.

However, applicants respectfully submit that the absence of this teaching is not the only shortcoming of Gaul. As set forth hereinabove with respect to the previous rejection, Gaul fails to support a rejection of independent claim 1, and thus fails to support a rejection of claims 8-10 under M.P.E.P. § 2141.03.

Turning now to claim 105, applicants respectfully submit that claim 105 relates to a subset of the subject matter encompassed by claim 1. Since Gaul does not render obvious the subject matter of claim 1, applicants respectfully submit that it cannot be reasonably interpreted to render obvious the subject matter of claim 105.

Similarly and with respect to the rejection as applied to claim 109, applicants respectfully submit that claim 109 depends from claim 108. For the reasons set forth hereinabove with respect to the rejection over Gaul alone, claim 108 is believed to be distinguished over Gaul. As such, dependent claim 109 is also believed to be distinguished over Gaul under M.P.E.P. § 2141.03. Thus, applicants respectfully submit that the instant rejection of claim 109 is believed to be improper and should be withdrawn.

Similarly and with respect to the rejection as applied to claims 117-119, applicants respectfully submit that claims 117-119 depend from claim 112108. For the reasons set forth hereinabove with respect to the rejection over Gaul alone, claim 112 is believed to be distinguished over Gaul. As such, dependent claims 117-119 are also believed to be distinguished over Gaul under M.P.E.P. § 2141.03. Thus, applicants respectfully submit that the instant rejection of claims 117-119 is believed to be improper and should be withdrawn.

And finally, applicants respectfully submit that like claim 105, claim 135 relates to a subset of the subject matter encompassed by claim 1. Since Gaul does not render obvious the

subject matter of claim 1, applicants respectfully submit that it cannot be reasonably interpreted to render obvious the subject matter of claim 135.

Summarily, applicants respectfully submit that the Patent Office has not presented a *prima facie* case of obviousness of any of claims 8-10, 105, 109, 117-119, and 135 have been rejected over Gaul, and further in view of Heimann, Nieendick, or Folkard. As such, applicants respectfully request that the instant rejections be withdrawn at this time.

II.F. Response to the Rejection over Gaul, and further in view of Myers, II

Claims 20, 27-32, 123, and 126-128 have been rejected over Gaul and further in view of Myers, II. Applicants respectfully disagree that Gaul in view of Myers, II supports the instant rejection.

Turning first to the rejection of claims 20 and 27-32, applicants respectfully submit that for at least the reasons set forth hereinabove, Gaul fails to support a rejection of claim 1 under 35 U.S.C. §103. Myers, II does not cure the deficiencies of Gaul, and thus the combination of Gaul in view of Myers, II does not support a rejection of claim 1.

Furthermore, 20 and 27-32 all depend from claim 1, and thus are believed to be distinguished over Gaul in view of Myers, II under M.P.E.P. § 2141.03.

Turning now to the rejection as applied to claims 123 and 126-128, these claims all depend from claim 112, and thus are believed to be distinguished over Gaul in view of Myers, II under M.P.E.P. § 2141.03 since Gaul does not support a rejection of claim 112 under 35 U.S.C. §103(a) and 103(a) and Myers, II does not cure the deficiencies of Gaul.

Accordingly, claims 20, 27-32, 123, and 126-128 are believed to have been distinguished over Gaul in view of Myers, II. As a result, applicants respectfully request that the instant rejection of claims 20, 27-32, 123, and 126-128 under 35 U.S.C. §103(a) be withdrawn at this time.

II.G. Response to the Rejection over Gaul in view of Carbonell

Claim 5 has been rejected over Gaul in view of Carbonell. According to the Patent Office, Carbonell cures the deficiency of Gaul that relates to the use of an isopropyl benzoic acid ester.

Applicants respectfully submit, however, that Gaul does not support a rejection of claim 1 under 35 U.S.C. §103(a) for the reasons set forth hereinabove. Given that claim 5 depends from claim 1, applicants respectfully submit that claim 5 is also believed to be distinguished over Gaul, whether alone or in combination with Carbonell, under M.P.E.P. § 2141.03.

Accordingly, applicants respectfully submit that claim 5 is believed to have been distinguished over Gaul in view of Carbonell. As a result, applicants respectfully request that the instant rejection of claim 5 under 35 U.S.C. §103(a) be withdrawn at this time.

II.H. Response to the Rejection over Gaul in view of Heimann, Nieendick, or Folkard, and further in view of Carbonell and Smith or Zeilinger

Claims 106, 107, and 111 have been rejected over Gaul in view of Heimann, Nieendick, or Folkard, and further in view of Carbonell and Smith or Zeilinger. According to the Patent Office, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use isopropyl benzoic acid ester in the composition taught by Gaul, with a reasonable expectation of success.

Applicants respectfully note, however, that if one of ordinary skill in the art were to add isopropyl benzoic acid ester in the composition taught by Gaul, the resulting composition would not be the instantly claimed compositions. As set forth hereinabove in more detail, the composition taught by Gaul necessarily includes a lactone. The instantly claimed compositions, on the other hand, do not require the presence of a lactone. As such, if one of ordinary skill in the art were to use isopropyl benzoic acid ester in the composition taught by Gaul, one of ordinary skill in the art would not arrive at the instantly claimed subject matter.

Furthermore, instant claims 106, 107, and 111 all depend from instant claim 105. As set forth in more detail hereinabove, Gaul in view of Heimann, Nieendick, or Folkard do not support a rejection of claim 105 under 35 U.S.C. § 103(a), and applicants respectfully submit that Carbonell and Smith or Zeilinger fail to cure the deficiencies of Gaul in view of Heimann, Nieendick, or Folkard.

Therefore, applicants respectfully submit that the instant rejection of claims 106, 107, and 111 over Gaul in view of Heimann, Nieendick, or Folkard, and further in view of Carbonell and Smith or Zeilinger is believed to be improper. As a result, applicants respectfully request that the instant rejection be withdrawn at this time.

Applicants further respectfully submit that claims 1-42 and 105-135 are believed to be in condition for allowance, and respectfully solicit a Notice of Allowance to that effect.

III. Response to the Obviousness-type Double Patenting Rejection

Claims 1-19, 21-28, 33-43, 105-122, 124-126, and 129-135 have been rejected under the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-12 of Zaki in view of Carbonell. According to the Patent Office, it would have been obvious to one of ordinary skill in the art to use a benzoic acid ester solvent in the cleaning

composition claimed by Zaki because Carbonell teach the use of solvents such as benzoic acid esters in similar cleaning compositions, and further because Zaki claims the use of various co-solvents and diluents which would encompass benzoic acid ester solvents.

After careful consideration of the rejection and the Patent Office's basis therefor, applicants respectfully traverse the rejection and submit the following remarks.

Initially, applicants respectfully submit that the instant rejection suffers from the same improper term interpretation that was present in the rejection over Heimann in view of Carbonell. Particularly, applicants respectfully submit that the Patent Office has misinterpreted the nature of "co-solvent" as that term is employed in Zaki, which leads it to incorrectly assert that one of ordinary skill in the art would interpret "co-solvent" to encompass benzoic acid esters. Applicants respectfully submit that the Patent Office has provided no reasonable basis for concluding that one of ordinary skill in the art would have interpreted "co-solvent" to be equivalent to "a second solvent".

Furthermore, applicants respectfully submit that the issue under the judicially created doctrine of non-statutory obviousness-type double patenting is whether the instantly claimed subject matter is obvious over the claims of Zaki. Thus, applicants respectfully submit that the inquiry is whether addition of benzoic acid ester solvents to the claimed subject matter of Zaki would lead one of ordinary skill in the art to arrive at the instantly claimed subject matter. Applicants respectfully submit that it is clear that it would not.

To elaborate, applicants respectfully submit that with respect to the co-solvent, claim 1 of Zaki recites that the co-solvent is present in about 0.5% to about 20%. Claim 11 recites that the co-solvent is present in about 0.5% to about 0.2%. Claim 12 does not recite any co-solvent at all.

As such, applicants respectfully submit that even assuming *arguendo* that one of ordinary skill in the art *might* have combined Zaki and Carbonell, at best one of ordinary skill in the art would have employed about 0.5% to about 20% of the co-solvent, about 0.5% to about 0.2% of the co-solvent, or no co-solvent at all.

Turning now to the instantly claimed subject matter, applicants respectfully note that at least claims 6, 7, 105-107, 111, 115, 116, and 135 are clearly outside of the scope of the claims of Zaki, even if one of ordinary skill in the art would have added a benzoic acid ester to Zaki's claimed composition.

With respect to claims 1-5, 8-19, 21-28, 33-43, 108-110, 112-114, 117-122, 124-126, and 129-134, applicants further respectfully submit that the Patent Office's mere assertion that Zaki "claims the use of various cosolvents and diluents which would encompass benzoic acid

ester solvents" (see Non-Final Official Action at page 16) is precisely the sort of conclusory statement that was prohibited in *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Summarily, the Patent Office provides no "articulated reasoning with some rational underpinning" to support its assertion that one of ordinary skill in the art would interpret "cosolvent" as employed in Zaki in such a way as to encompass benzoic acid ester solvents, and further fails to provide any requisite reasoning to support its assertion that one of ordinary skill in the art would have considered benzoic acid ester solvents to be "diluents".

Accordingly, applicants respectfully submit that the instant obviousness-type double patenting rejection of claims 1-19, 21-28, 33-43, 105-122, 124-126, and 129-135 over claims 1-12 of Zaki in view of Carbonell is believed to be improper, and applicants respectfully request that it be withdrawn at this time. Applicants further respectfully submit that claims 1-42 and 105-135 are in condition for allowance, and respectfully solicit a Notice of Allowance to that effect.

#### CONCLUSIONS

Should there be any minor issues outstanding in this matter, the Examiner is respectfully requested to telephone the undersigned attorney. Early passage of the subject application to issue is earnestly solicited.

#### DEPOSIT ACCOUNT

The Commissioner is hereby authorized to charge any deficiencies or credit any overpayments associated with the filing of this correspondence to Deposit Account Number **50-0426**.

Respectfully submitted,

JENKINS, WILSON, TAYLOR & HUNT, P.A.

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